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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,375	05/21/2002	William H Hohenstein	55178-015	9477
20277	7590	10/06/2003	EXAMINER	
MCDERMOTT WILL & EMERY 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			MISKA, VIT W	
			ART UNIT	PAPER NUMBER
			2841	

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,375

Applicant(s)

HOHENSTEIN ET AL.

Examiner

Vit W. Miska

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-3, 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by the U.S. Patent to Wilkens. The reference discloses a wearable timepiece including concentric conical bands 112, 113 rotating around bezel 111, the latter serving as a mounting platform for a decorative object (the design on bezel 11 shown in Fig. 5).
2. Claims 1,2,5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Chaut. Concentric rotating bands 13, 16 rotating about bezel 12 mounting decorative object 15.
3. Claims 4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by the Swiss patent to Spadini ('979). The reference discloses rotating cylindrical band 20 and rotating bezel 24 serving as a mounting platform for decorative object 25.

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4. Claims 8,9 and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by the EP Patent to Perrot ('717). The reference discloses a wearable timepiece with visible surface 2 and mounting mechanism (stud) 10 for removably attaching decorative object 6.

5. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Namisato or Kienberger. Namisato discloses decorative object 3 attached to spring mechanism 2 of a timepiece. Kienberger shows decorative object 26, 28, 30, 32, 34 and the pendulum shown in Fig. 1, attached to spring mechanism 18.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kienberger. Stud 28 engages spring 18 with U-shaped portions 20. These correspond to a wishbone shape as shown in applicant's Fig. 6.

7. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Namisato. The attachment of decorative object 3 to spring member 2 is suggested to be by means of an adhesive. However, one skilled in the art would recognize that the two elements may be attached in any other suitable manner, such as with a screw. With regard to claim 14, spring 18 includes parallel legs 20 defining a slot therebetween as shown in Fig.6. The spring is suggested to be made of plastic (col. 3, line 13), however, it would be obvious for one skilled in the art to make spring 18 of other materials having sufficient elasticity as noted at col.3 line 1 to accommodate elements 26, 28.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 10-11 and 15-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 10-11 lack antecedent basis for "said stud". Claim 15 recites "the slot has a hole at a location along its length". This language is inaccurate because the "hole" claimed is actually made in the spring and not the slot, as the latter cannot by definition contain any structure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vit W. Miska whose telephone number is 703-308-3096. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Martin can be reached on 703-308-3121. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4900.



Vit Miska
Primary Examiner

VM
9/29/2003